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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/030,778 | 01/07/2002 | Michihiro Kawada | TSUT8.001 APC | 6363 |
| 20995 | 7590 | 07/15/2004 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | BUTLER, DOUGLAS C | |
| 2040 MAIN STREET | | | ART UNIT | |
| FOURTEENTH FLOOR | | | PAPER NUMBER | |
| IRVINE, CA 92614 | | | 3683 | |

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,778

Applicant(s)

KAWADA ET AL.

Examiner

Douglas C. Butler

Art Unit

3683

MB

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) 2, 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 and 14-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3683

Detailed Action

1. An action on the merits of claims 1, 3-6, and 14-16 is included in this office action as considered readable on Species B (Figs. 6-8).

2. Claims 2 and 7-8 are withdrawn from consideration 37 C.F.R. § 1, 142(b).

Election was made without traverse in Paper No. 6 filed on September 29, 2003.

3. Claims 9-13 have been canceled.

4. The examiner appreciates applicants filing copies of the requested references. The examiner has considered the references. A copy of Form PTO-1449 is enclosed for applicants' files.

5. Applicants should note that the examiner has requested translations of the non-English reference submitted by applicants on April 9, 2004 from STIC within the USPTO and intends to attach translations with the next office action, if available. ~~Since~~ *Should* applicant obtain translations independently of the USPTO, a copy of it should be forwarded to the examiner for inclusion in the file. JP 63-36804 includes a spherical surface 19 in Figs. 1-3 which may be significant once a translation is obtained. No rejection is made at this time using this document since to do so would involve speculation by the examiner as to what the document fairly teaches.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Clarification of Record Applicants state on page 6 that the examiner made in statement in the prior office action of Jan. 6, 2004 which the examiner did not, in fact, make.

Applicants incorrectly state that:

"The Examiner asserts that applicant should submit copies of any documents cited in PCT/JP01/06473 which corresponds to applicant's S.N. 10/129,706 in order to maintain this clear line of patentable distinction between the instant claims and the claims of applicant's S.N. 10/129,706."

To correct the record, the examiner stated "Applicant and/or assignee should maintain this clear line of patentable distinction between the instant claims and the claims of applicant's S.N. 10/129,706."

The examiner then stated that "if available, applicants should submit copies of any document cited in PCT/JP01/06474 which corresponds to applicant's S.N. 10/129,706."

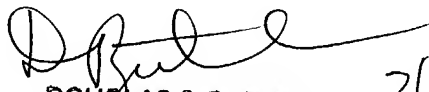
8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The detailed description appears to lack an antecedent basis for the phrase "partial sphere" of each of the independent claims.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 3-6 and 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,712,370 to Kawada et al, newly cited. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are directed to an obvious variation of the invention defined by claims 1-4 of Kawada et al (370).
11. The U.S. references cited in US 6712370 to Kawada et al have been considered.
12. Any inquiry concerning this communication should be directed to Exmr. Butler at telephone number (703) 308-2575.


DOUGLAS C. BUTLER
PRIMARY EXAMINER
7/13/04
AU 3683

Butler/vs
July 12, 2004